UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/695,744	10/24/2000	Thomas J. Perkowski	100-046USA000	2224

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Thomas J Perkowski Esq
Thomas J Perkowski Esq P C
Soundview Plaza
1266 East Main Street
Stamford, CT 06902

EXAMINER
CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/695,744	PERKOWSKI, THOMAS J.
	Examiner	Art Unit	
	Jeffrey D. Carlson	3622	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _05 May 2005_.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _351-395_ is/are pending in the application.

  4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _351-395_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a)☐ All b)☐ Some * c)☐ None of:

  1.☐ Certified copies of the priority documents have been received.

  2.☐ Certified copies of the priority documents have been received in Application No. _____.

  3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Applicant's Response to Notice of Informality re: Payment of Fee

Applicant states that because he canceled claim responsive to the Notice to File Missing

Parts and Fee Due, he is not responsible for excess claims fees for claims that have been

canceled. According to MPEP 607 III, the Examiner believes applicant to be correct in this

regard.

Claim Scope Analysis

Applicant's claims include a large amount of language that does not positively limit the

claims or renders the claim scope indefinite. The claims are "system" claims and are taken to set

forth structural apparatus as applicant's invention. As such, applicant's claims must provide

structural limitations in order to define limiting claim scope.

Looking at claim 351 as an example, a RDBMS is clearly set forth, yet the central

database of links is not. The "for storing" is taken to represent non-limiting functional language.

Examiner recommends stating "a...RDBMS with a central database of links stored therein" or

similar in order to positively set forth the structure of a database containing such records.

Further, applicant's "UPN/TM/PD/URL" description of the links does not define any structure

beyond mere "links" and the slashes appear to present alternatives rather than inclusive

requirements. Next, applicant positively sets forth subsystems, yet much o the language

associated therewith is not taken to structurally limit the claims. For example the "for

enabling...to create and manage a local database..." is again functional language, but would

represent positively claimed structure if re-worded as "a first subsystem programmed to…(accomplish the functionality)." By requiring the subsystem to be programmed to perform certain step(s), applicant is providing claimed structure rather than mere functional language. Further however, even if the functionality to create and manage were claimed as programmed structure, the "links related to the consumer products of the manufacturer being offered for sale in both physical and/or electronic marketplaces" language goes far beyond any structure that may be provided by links in a database. In other words, a subsystem that enables creation and management of a local database of links is the same subsystem structure regardless of what the links represent. The particular steps of offering for sale and the location of these sales do not limit this claim, especially given that it is not a method claim. Applicant's associated language that describes apparent method steps will not positively limit the structure in these claims. Applicant's description of who can perform certain acts does not define the acts, nor any structure of a system programmed to execute the acts. The particular parties (manufacturer, advertiser, agents, users, etc) who use a system do not define the details or structural limitations of a system. Lastly, applicants reasoning for providing or effects achieved when using the claimed structure ("so as to cerate a bran image", etc.) also does not further define the structure. Other claims are similarly analyzed.

Claim Objections

1.   Claims 380-395 are objected to because of the following informalities:

■   Claims 380-395 should be renumbered as 379-394 because applicant has apparently failed to submit a claim 379.

■   Claim 382 depends from canceled claim 35.

■   Claim 389 depends from non-existent claim 402.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3.   Claims 351-395 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

■   Claim 353, it is unclear what the scope and meaning of a CPI kiosk and CPIR-

enabling applets.

■   Claims 351, 353, 358, 359, 363, 370, 373, 382, 385, 387, recite either "e.g.", "i.e.",

"and/or" or "for example", each of which renders the claim indefinite. Examiner

requests applicant to further review the claims for similar problems not noted herein

by the examiner.

■   Claim 369, there is no antecedent basis for a MIN or UPN filter. Further, the

language that these filters might be maintained renders the claim scope unclear.

■   Claim 370, it is unclear what a GSU-enabled computer requires, rendering the claim

scope unclear.

■   Claim 380, there is no antecedent basis for the kiosk deployment directory.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

5.   **Claims 351-368, 371-395 are rejected under 35 U.S.C. 103(a) as being unpatentable**

over Stern (US6591247).

Regarding claims 351, 352, 354, 359-363, 367, 368, 373-376, 379, 383, Stern teaches

systems and methods for providing networked, in-store kiosks that can be used to deliver product

information and advertisements. A centralized server (NMC/NOC 12/20) receives various types

of content (ads, information, audio, video, etc) and makes the content available to various stores

[fig 1]. Each store has plural kiosk sites 30 including a video screen, keyboard and light pen.

The kiosks and servers are connected by way of IP protocol and/or the Internet [4:46-68]. A

consumer can scan the UPC (i.e. UPN – universal product number) barcode of a product at the

kiosk and receive advertising and other information about the product [6:46-50, 7:14-17, 27-32,

48-50] which provides a positive brand experience. Applicant claims "UPN/TM/PD/URL links"

and provides language describing what each acronym stands for, yet no structure is positively

claimed other than "links". Stern teaches that the central database provides a UPC-indexed

database of products that stores the relationship (via the tblUPCmaster table) between the UPC

codes and the associated content (ads, information, audio, etc) associated with that product [8:10-

25]. The UPC codes of Stern are taken to be equivalent to applicant's UPN in that they both

provide an item identifier to be used for database lookups to retrieve and deliver advertising and

item information. Stern teaches that functionality is provided to input ads/information into the

system [6:1-34] which is taken to represent programming of the various information modes. The

particular mechanism for the outside entities (manufacturers, advertisers, etc) to access and enter

information into the system is not stated by Stern. Official Notice is taken however that EDI

techniques are well known means for Business-to-Business data interchange and that software

tools are known to be provided to the participants in order that they may deliver locally stored

information to their business partners. It would have been obvious to one of ordinary skill at the

time of the invention to have provided EDI tools for the plural manufacturer and advertiser

workers to store their data locally in a particular format (i.e. in a local database) and deliver the

information (product information, product ads, etc) to the central system of Stern. In this

manner, the central system of Stern can be refreshed with updated information that can be

distributed and consumed by requesting consumers.

Regarding claim 353, 378, Stern does not state that the kiosks include touch screens or

wireless communications. However Official Notice is taken that both of these technologies are

well known to be provided with kiosks it would have been obvious to have provided a touch

screen for easy data entry as well as wireless for ease of kiosk installation.

Regarding claim 355, the details of the virtual kiosks are essentially optional as claim 353

states that the virtual kiosks themselves are optional. Further, the location of a kiosk does not

define any structural limitation to the kiosk is such an apparatus claim. A kiosk that delivers

web-based product information pages is taken to be no different structurally from a user's PC

that displays web-based product information pages. Therefore, the in-store kiosks of Stern can

also be considered to be virtual kiosks – the information is provided virtually in either case via a

physical device and display.

Regarding claims 356, 358, Stern teaches that the available information is based upon

factors such as the products present in a store [4:15-17].

Regarding claims 357, 371, 386, the code necessarily present at the web server that

dynamically delivers the requested HTML and other formatted product information and

advertising from the stored databases is taken to met the "applet/tag" language.

Regarding claim 364, 384, 387-395, Durst, Jr. et al teaches details of providing

advertising for the system. Ads may be submitted with date codes defining when an ad

campaign is active. Ads may be provided for products that are physically located on nearby

shelves, aisles. Ads may be specified to be piggybacked and defined as associated with specific

products [7:14-40]. It would have been obvious to one of ordinary skill at the time of the

invention to have enabled an advertiser or manufacturer to log in and view the available and

relevant kiosks in order to purchase ad placements with specific kiosks [8:63 teaches site

identifiers]. Stern teaches that a user interface may be provided for access into the information

and advertising databases [8:43-48]. Stern teaches that logs and statistics are kept regarding

consumer use patterns and which products were requested for content/ads [7:8-10].

Regarding claims 365. 366, the fourth subsystem is optional as per applicant's claims.

Regarding claim 372, the advertising content can be taken to be pre-purchase information

whereas the other product information would be useful as post-purchase information.

Regarding claim 377, Stern appears to only teach access to product information via an input UPC. it would have been obvious to one of ordinary skill at the time of the invention to have provided ca menu of product categories so that the consumer could more effectively browse for items in various categories without having to retrieve samples of each item to scan the UPC. It would have been obvious to one of ordinary skill at the time of the invention to have enabled the manufacturer to select or define his product categorization in order to organize his products within such a menu-based system.

Regarding claims 380-382, Stern teaches that the system stores information regarding the retail stores themselves such as siteID [8:63] as well as a mapping of which products are available in a particular store [8:26-30]. It would have been obvious to one of ordinary skill at the time of the invention to have provided access for the retailer in order to provide and maintain this information. Further, the system is taken to support retailer registration and ordering/installing of such kiosks in a requesting retailer's store.

Regarding claim 385, Stern teaches that the kiosks may automatically display advertising during an attract loop which is taken to play automatically during idle periods [17:33-37]. Further, Stern teaches that a sequence of ads can be played in a series [7:30-35] which is taken to be programmatically displayed.

6.   **Claims 369, 370 and 365, 366, 392-395 (alternatively) are rejected under 35 U.S.C. 103(a) as being unpatentable over Stern (US6591247) in view of Durst, Jr. et al (US6542933).**

Regarding claims 365, 366, 392-395, although any advertisement content delivered

through an advertising mode is taken to promote the item advertised, therefore providing a

promotion and promotion mode, Durst, Jr. et al teaches delivery of product information

responsive to requests for UPC/UPN-specified product information. Durst, Jr. et al teaches that

product descriptions as well as product promotions are provided to the user [col 23 lines 7-29].

It would have been obvious to one of ordinary skill at the time of the invention to have provided

a mode for registered promoters to input product promotions and view/manage the promotions in

the system for retrieval by consumers as well Stern's displaying advertising mode and product

information mode in order to provide more brand awareness and encourage the consumer to

purchase a particular brand.

Regarding claim 369, Durst, Jr. et al teaches that users may specify their preferred

language [3:54-55] and it would have been obvious to one of ordinary skill at the time of the

invention to have tailored the content responses to the user in their language of choice.

Regarding claim 370, Durst, Jr. et al teaches that the requesting devices may be varied:

PC as well as web enabled cellphone and PDA [5:32-37]. It would have been obvious to one of

ordinary skill at the time of the invention to have to have provided a WAP-enabled web server in

order to deliver reduced-format information to a PDA with limited bandwidth, processing power

and screen size. Official Notice is taken that web servers include some sort of time

synchronization at it would have been obvious to one of ordinary skill at the time of the

invention to have provided any well known mechanism for this such as GPS-synchronization in

order to define the system time.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
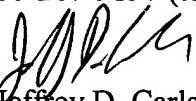
Jefffey D. Carlson
Primary Examiner
Art Unit 3622

jdc